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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/679,585	10/06/2003	Ryoichi Hosoya	17092	5930
23389 7590 01/22/2009 SCULLY SCOTT MURPHY & PRESSER, PC 400 GARDEN CITY PLAZA SUITE 300 GARDEN CITY, NY 11530				
EXAMINER				
NGUYEN, TRAN N				
ART UNIT		PAPER NUMBER		
3626				
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01/22/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/679,585

**Applicant(s)**

HOSOYA, RYOICHI

**Examiner**

Tran Nguyen

**Art Unit**

3626

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/ICE)  
Paper No(s)/Mail Date 10/06/2003, 04/23/2007, 10/03/2008
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_



**DETAILED ACTION**

***Notice to Applicant***

This communication is in response to the communication filed 10/03/2008.

Pending claim(s): 1-9.

***Priority***

Acknowledgment is made of Applicant's claim for priority to application 2002-322216 filed in Japan on 11/06/2002.

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

***Information Disclosure Statement***

The information disclosure statement (IDS) submitted on 10/06/2003, 04/23/2007, 10/03/2008 is entered and considered by Examiner.

***Claim Objections***

Claim 1 is objected to because of the following informalities: "a **medial** institution".

Appropriate correction is requested.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim(s) 9 is/are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per claim 9, this claim is treated under 35 USC 112, 6th paragraph as required by MPEP 2181(I).

To avoid purely functional claiming in cases involving computer-implemented inventions, we have "consistently required that the structure disclosed in the specification be more than simply a general purpose computer or microprocessor." *Aristocrat Techs. Austl. Pty Ltd. v. Int'l Game Tech.*, 521 F.3d 1328, 1333 (Fed. Cir. 2008). "Because general purpose computers can be programmed to perform very different tasks in very different ways, simply disclosing a computer as the structure designated to perform a particular function does not limit the scope of the claim to 'the corresponding structure, material, or acts' that perform the function, as required by section 112 paragraph 6." *Id.* "Thus, in a means-plus-function claim 'in which the disclosed structure is a computer, or microprocessor, programmed to carry out an algorithm, the disclosed structure is not the general purpose computer, but rather the special purpose computer programmed to perform the disclosed algorithm.'" *Id.* (quoting *WMS Gaming, Inc. v. Int'l Game Tech.*, 184 F.3d 1339, 1349 (Fed. Cir. 1999)). Consequently, a means-plus-function claim element for which the only disclosed

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structure is a general purpose computer is invalid if the specification fails to disclose an algorithm for performing the claimed function. See *id.* at 1337-38.

In particular, the specification does not clearly set forth the algorithm for performing the recited “means for storing” and “means for calculating”.

For purposes of applying prior art, Examiner interprets these limitations to recite purely functional limitations.

Additional clarification is requested.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim(s) 1-6, 8-9 is/are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As per claim 1, this claim recites a “system” comprising a plurality of “unit” limitations.

In applying the broadest and most reasonable interpretation in light of the specification and the level of ordinary skill in the art, Examiner interprets these limitations to envelop software *per se* embodiments.

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While Examiner recognizes that these limitations envelop hardware embodiments, the fact that these limitations also envelop software *per se* embodiments renders the entire claim nonstatutory.

All claims dependent thereon, namely claims 2-5, fail to remedy these deficiencies, and are therefore rejected for at least the same rationale above, and incorporated herein.

As per claim 6, based on Supreme Court precedent and recent Federal Circuit decisions, the Office's guidance to examiners is that a § 101 process must (1) be tied to a machine or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. *In re Bilski* et al, 88 USPQ 2d 1385 CAFC (2008); *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780,787-88 (1876).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a statutory process, the claim should positively recite the particular machine to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

In particular, the method steps do not require the particular machine nor do they produce a physical transformation. Therefore, claim 6 fails the "machine

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or transformation" test, and is found to be directed towards nonstatutory subject matter.

As per claim 7, this claim recites "a storage medium".

The specification discloses (page 33-34):

25           Additionally, a storage device 36, which is  
  
included/externally attached in/to a program server 35  
connected to the computer 31 via a communications  
network 34, may be a storage medium. In such a case,  
a transmission signal obtained by modulating a carrier  
5 wave with a control program recorded on the storage  
device 36 on the program server 35 side may be  
transmitted from the program server 35 side, and the  
control program may be demodulated from the transmission  
signal received via the communications network 34, and  
10 the CPU may be made to execute the control program on  
the computer 31 side.

According to the specification, in an exemplary embodiment, the "medium" is capable of providing data to be transmitted by modulating a carrier wave.

Examiner interprets the specification to disclose that modulating a carrier wave is a functional limitation of the disclosed invention, wherein the carrier wave is not an exemplary embodiment of the "medium".

Therefore, this claim is found to be statutory in view of the specification and the level of ordinary skill in the art because "medium" is given its plain and ordinary meaning in the context of the disclosure.



As per claim 8, this claim recites a "a computer data signal embodied in a carrier wave".

"A transitory, propagating signal like Nuijten's is not a process, machine, manufacture, or composition of matter.' ... Thus, such a signal cannot be patentable subject matter." *In re Nuijten*, Docket no. 2006-1371 (Fed. Cir. Sept. 20, 2007)(slip. op. at 18)

Therefore, claim 8 is directed towards nonstatutory subject matter.

As per claim 9, as discussed in the section above, this claim recites a "system" comprising purely functional limitations devoid of any particular structure.

Therefore, claim 9 is interpreted to envelop software *per se* embodiments, and is found to be directed towards nonstatutory subject matter.

Additional clarification is requested.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim(s) 1-9 is/are rejected under 35 U.S.C. 102(b) as being anticipated by Macario (Estimating the Duration of a Case When the Surgeon Has Not Recently Scheduled the Procedure at the Surgical Suite).

As per claim 1, Macario teaches a system (page 1241 column 1 paragraph 1) capable of predicting a new case's duration (reads on "assisting in a medical service", wherein the prediction is used by the OR scheduling system to accommodate the case) (page 1241 column 1 paragraph 1), comprising:

(a) software (reads on "an examination conduct information storing unit") capable of storing the duration of medical procedures (reads on "information occurring by conducting an examination in the medial institution") for a plurality of historical case (reads on "each time the examination is conducted") (page 1241 column 1 paragraph 1);

(b) software (reads on "a totaling unit") capable of predicting the time required for the new case (reads on "a total amount of time required for conducting the examination") based on similar cases derived from the historical data (reads on "indicated by the examination conduct information") (page 1241 column 1 paragraph 1).

As per claim 2, Macario teaches that historical case data is stored in the system. Therefore, it is inherent that the data was inputted using some input means capable of providing the data to the system. Examiner considers this

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input means to be "an obtaining unit" capable of "obtaining an input of the examination conduct information" (page 1241 column 1 paragraph 1).

Macario further teaches providing the data to the scheduling system (reads on "displaying", wherein data is provided from one module to another") (page 1241 column 1 paragraph 1).

As per claim 3, Macario teaches the duration required for a surgery (reads on "a total for each doctor who is responsible for the examination" and "each examination technique in the examination") (page 1241 column 1 paragraph 1).

Examiner considers an operation to be an "examination" because the patient is being examined in the course of surgery.

Insofar as the remainder of the claim is concerned, the applied art need not teach these limitations in view of the optional limitations recited therein.

As per claim 4, Macario teaches using the mean of historical cases similar to the new case to predict the new case's duration (page 1241 column 1 paragraph 1).

As per claim 5, Macario teaches displaying the mean calculated by the computer and printing the mean as a chart (reads on "graphing") (page 1244 Table 1).

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As per the set of claim(s): 6, 7, 8, 9, this set of claim is rejected for substantially the same rationale as applied to the rejection of the set of claim(s): 1, 1, 1, 1, respectively, and incorporated herein.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tran (Ken) N. Nguyen whose telephone number is 571-270-1310. The examiner can normally be reached on Monday - Friday, 9:00 am - 5:00 pm Eastern.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, C. Luke Gilligan can be reached on 571-272-6770. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service

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Representative or access to the automated information system, call 800-786-

9199 (IN USA OR CANADA) or 571-272-1000.

/T. N./

Examiner, Art Unit 3626

01/17/2008

/C Luke Gilligan/

Supervisory Patent Examiner, Art Unit 3626